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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,411	03/24/2004	Frank Muir	08740001AA	3860
30743 7590 09/12/2008 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190				
EXAMINER DANIELS, MATTHEW J				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
09/12/2008		PAPER		

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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte FRANK MUIR

Appeal 2008-2961  
Application 10/807,411  
Technology Center 1700

Oral Hearing Held:

Before CHUNG K. PAK, TERRY J. OWENS, and  
ROMULO H. DELMENDO, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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1           The above-entitled matter came on for hearing on Tuesday, July  
2 15, 2008, commencing at 2:15 p.m., at The U.S. Patent and Trademark  
3 Office, 600 Dulany Street, Alexandria, Virginia, before Laurel P. Platt,  
4 Registered Diplomat Reporter, Notary Public.

5           THE CLERK: Calendar Number 42, Appeal Number 2008-  
6 2961, Mr. Whitham.

7           MR. WHITHAM: Good afternoon. I'm Mike Whitham. I  
8 brought my observer with me, a rising senior at a local high school who is  
9 working in my office and thinking about going to engineering school. So I  
10 thought this would be a good trip.

11           JUDGE PAK: Thank you, Mr. Whitham. As you know, you  
12 have 20 minutes to argue your case.

13           MR. WHITHAM: Right.

14           JUDGE PAK: We have a court reporter here today who is  
15 going to transcribe the entire hearing, which means your statements will  
16 become part of the record.

17           MR. WHITHAM: No trouble.

18           For today, I want to focus only on claim 1 because everything  
19 else is in the record in the case.

20           I did want to start out with kind of identifying what's not new.  
21 Okay? The examiner cited this reference to Harris, and you will see that  
22 Harris is a tube, and it's got a magnifying glass in the top. So the idea of  
23 having a magnifying glass and a cap on some device, that's not new. That's  
24 not what we are claiming.

25           This reference to Owens, Owens teaches using a compound  
26 press device for taking blanks of material, pressing them into a lens shape.

1 He teaches making a variety of different type of lens devices, some for  
2 cameras, some for microscopes, a variety of other things. The idea of  
3 pressing plastic material into a lens shape, that's not new.

4 We even go so far as to say that pressing a material into a lens  
5 for a variety of different applications, that's also not new. That's what's in  
6 the Owens reference.

7 What we're focusing our attention on in claim 1 is for making  
8 bottle caps. It has a couple of steps. One step is selecting the radius of  
9 curvature step. Here it requires you to select the radius of curvature of the  
10 magnifying lens that you want.

11 You will see that in Figures 4 and 5 of the application. For  
12 example, you may have different-size pill bottles. Some are thin. Some are  
13 wide. Okay.

14 And what you're selecting is the top, the radius of curvature of  
15 the lens itself. For example, a larger bottle might have a lower radius of  
16 curvature, and a smaller bottle, a smaller diameter bottle might have a larger  
17 radius of curvature.

18 JUDGE OWENS: Could they possibly give you the same  
19 magnification?

20 MR. WHITHAM: Could they possibly give you the same  
21 magnification? Yes, they could. Yes.

22 JUDGE OWENS: And that would be why you might do that?

23 MR. WHITHAM: That's correct, because essentially you're  
24 making the thickness about the same, so it would have the same magnifying  
25 power, that's correct.

26 The claim requires in lines 5 and 6 where it says, Wherein

1 different radiuses are selected for different-diameter bottle caps of the  
2 plurality of bottle caps.

3 The claim also has a step where we press the single piece of  
4 plastic, but at the bottom of the claim at lines 13 to 15, it says, Where the top  
5 portion of each bottle cap of said plurality of bottle caps to be made has said  
6 radius of curvature selected in the selecting step.

7 So the position that the examiners take and that we believe is in  
8 error and they're asking for relief there is that his position is that would be  
9 inherent.

10 He takes the Owens reference. He has cited to the claim which  
11 is in column 30 where it's talking about -- it says in line 30, The size and  
12 shape wanted in the finished element. Well, this is talking about the metal  
13 fixture that it uses to makes the lens.

14 I think that the Owens reference, when you look at column 3 of  
15 the Owens reference, you will see that what this reference is about is making  
16 precise lenses.

17 He says in column 3 at lines 5 onward, I may spend a relatively  
18 large amount upon the making of the two substantially perfect optical  
19 surfaces, one for the punch and one for the press. He concludes with, Thus,  
20 in mass production, the cost of each lens is cut drastically.

21 So the focus of Owens is to make very precise presses so that  
22 we can perhaps mass produce camera lenses or other devices.

23 But one thing that you are doing in Owens is you're making the  
24 same lens every time. There is no selecting of different-size radiuses in the  
25 Owens device. And it wouldn't be inherent.

26 I know that he's cited the Reinert, Gardner and Daily cases as

1 saying this would be a change in size and shape. That's really not the case.  
2 What we are doing is we are defining a process where we can handle  
3 different caps of different sizes and shapes.

4 JUDGE OWENS: Are you trying to get the same  
5 magnification for all of them?

6 MR. WHITHAM: We have not limited ourselves to the  
7 magnification. We have limited ourselves to having different bottle caps of  
8 different sizes and shapes and actually selecting a different angle for  
9 different-sized bottle caps.

10 The answer is we would be trying to get the same magnification  
11 because you would want this to be used by people when they're reading their  
12 pill bottles.

13 JUDGE PAK: Counsel, the claim only requires selecting a  
14 radius of a curvature for at least one of an upper or lower convex surface of  
15 the top portion of each bottle cap. Right? It doesn't require selecting plural  
16 radiuses. It only requires selecting a radius based on whatever size the bottle  
17 cap needed.

18 MR. WHITHAM: I don't read the claim that way, Judge.  
19 When we are selecting a radius, you have a bottle cap that needs to be  
20 pressed. You're looking for the radius of the top or the bottom for the lens  
21 that you are going to make, but we clearly require that wherein different  
22 radiuses are selected for different-diameter bottle caps with said plurality of  
23 bottle caps.

24 Now, if you had one stamp, okay, and you had different-sized  
25 bottle caps, much like Owens, you would wind up with different radiuses of  
26 curvatures in those different caps.

1 JUDGE PAK: Based on the teaching of Owens, when you are  
2 trying to form a plastic lens that comports with the particularly sized  
3 cameras or telescope, would you select particular radius of curvature that  
4 comports with the particularly sized camera?

5 MR. WHITHAM: Certainly what Owens is doing is making a  
6 precise lens for a camera. And so if we want to mass produce cameras, you  
7 are going to have to make the curvature of a specified size to make it work  
8 properly.

9 JUDGE PAK: You would select different radiuses of curvature  
10 depending on the size of cameras or depending on whether they want to use  
11 it for, for example, telescope versus binoculars.

12 MR. WHITHAM: Okay. The idea of having a manufacturing  
13 line where you are making a camera and making binoculars is not really  
14 what's going on in Owens. Either you are making cameras or you are  
15 making binoculars.

16 In our case what we do have, because of the pill industry and  
17 because you wind up with different size bottles, we are trying to have a  
18 process where we can make this magnifying lens for the different-type caps  
19 that are on these different-type bottles.

20 JUDGE OWENS: What if you are making different-size  
21 cameras or different-size telescopes? Then would you use a different radius  
22 of curvature?

23 MR. WHITHAM: Well, if you had telescopes that were going  
24 to have different magnifications, I assume that you would make the lenses  
25 differently. I don't know that, but I expect that you would make the lenses  
26 differently for different telescopes.

1                   But you would be making -- what I've tried to cover in this  
2 claim is the idea of having different-size caps that I'm going to use for  
3 bottles in a bottle-cap-making process.

4                   JUDGE PAK: Counsel, one more question. When you  
5 designed the size of this bottle cap, you are claiming that the bottle caps you  
6 are claiming include any size bottle caps. Am I correct?

7                   MR. WHITHAM: Well, you're right in the fact -- the part that I  
8 want to clarify there is you don't make these bottle caps. You get the bottle  
9 caps. They're made by vendors that are going to make these bottles. What  
10 you're doing is you're making the caps that fit those bottles.

11                   So you would have a big pile of bottles in a bag that you would  
12 then --

13                   JUDGE PAK: But as you cited, you are including bottle caps  
14 that comport with any size bottles, whether they are known at this point in  
15 time or known in any future time. Am I correct?

16                   MR. WHITHAM: You are correct. You would have to have  
17 different-diameter bottle caps, though, in the practice of this invention.

18                   JUDGE PAK: So those sizes could include the size that  
19 corresponds to the telescope attachment or the camera attachment. Am I  
20 correct in that, too?

21                   MR. WHITHAM: There would be no selection. You would be  
22 correct that if you wanted to use the Owens device to make telescopes, you  
23 would be able to press blanks.

24                   JUDGE PAK: If the bottle's opening corresponds to the size of  
25 the opening in the camera or telescope, the lens in the opening of a camera  
26 or telescope would correspond to your bottle cap. Am I correct?



1                   MR. WHITHAM: Well, I guess it's hard for me to envision  
2 putting a bottle cap in the opening of a camera. I mean, I do have  
3 requirements that the bottle cap that you make has some mechanism of  
4 affixing it to a bottle.

5                   I mean, I would agree, though, that what the Owens device  
6 teaches is that I can press lenses for different applications. What it doesn't  
7 teach is an application where I can press bottle caps. It doesn't teach a  
8 process where I select the radius for the bottle cap.

9                   JUDGE OWENS: So your method of making bottle caps  
10 requires making more than one cap.

11                  MR. WHITHAM: That's correct.

12                  Thank you.

13                  JUDGE PAK: Any questions?

14                  Thank you for coming.

15                  Whereupon, the proceedings at 2:28 p.m. were concluded.